UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/608,077	06/30/2003	Paul D'Angio	9516-034-999	7850

20582 7590 06/29/2006

JONES DAY
51 Louisiana Avenue N.W.
Washington, DC 20001-2113

EXAMINER	
ROBERTS, LEZAH	

ART UNIT	PAPER NUMBER
1614	

DATE MAILED: 06/29/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action Before the Filing of an Appeal Brief	**Application No.** 10/608,077	**Applicant(s)** D'ANGIO ET AL.	
	Examiner Lezah W. Roberts	**Art Unit** 1614	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 08 June 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:
   a) ☐ The period for reply expires _____months from the mailing date of the final rejection.
   b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

   Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
   (a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
   (b) ☐ They raise the issue of new matter (see NOTE below);
   (c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
   (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

   NOTE: *See Continuation Sheet*. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
   The status of the claim(s) is (or will be) as follows:
   Claim(s) allowed: _____.
   Claim(s) objected to: _____.
   Claim(s) rejected: *24-35*.
   Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: See attached correspondance.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____
13. ☐ Other: _____.

L. Roberts
Patent Exmr.
Art Unit 1614

A. Marschel
SPE
Art Unit 1614

Continuation of 3. NOTE: Claim 26 would depend from a canceled claim 25 and claim 33 would depend from a cancelled claim 32.

DETAILED ACTION

Interview

A personal interview was held on June 6, 2006 between Examiners Marschel, Krass and Roberts; and Messrs. Choi and Girards. The subject of the new matter rejection made in the office action dated April 19, 2006 was discussed as well as the 103 rejections and data submitted by the Applicants to substantiate unexpected results. No agreement was reached as to the patentability of the claims.

Response to Remarks

If the amended claims had been entered, the New Matter rejection of the prior office action regarding "direct blend" as discussed at the Interview held June 6, 2006 would have been overcome.

In regards to the unexpected results, the Applicant has submitted data comparing the old 50 mg thalidomide formulation and new 50 mg thalidomide formulation but fails to specify in the communication what the old and new formulations contain. The carriers incorporated into the two formulations were not disclosed in the document; therefore, it is not clear what formulations are being compared. The document was not considered and does not show unexpected results.

In regards to the claims, it appears the component that the Applicant stresses that differentiates the formulation of thalidomide of the instant claims from the formulations of the prior art is the capsule size. It would appear obvious to use the

appropriate capsule size for the amount of ingredient being placed in the capsule. Govindarajan et al. (6,914,067) discloses different dosage forms comprising thalidomide. The typical dosage forms of the reference include 1 mg to 1000 mg; 50 mg to 1000 mg; 100 mg to 750 mg and 200 mg to 500 mg of thalidomide. The dosage forms include capsules. This reads on the instant claims in regards to the amount of thalidomide comprised in the capsules. The reference also makes reference to methods of preparing the dosage forms by referring to Remington's Pharmaceutical Sciences, 18th ed., Mack Publishing, Easton Pa. (1990), an older edition of one of the references (Gennaro) used in the rejection of the claims in the prior office actions. This reference teaches capsules sizes and how much can fit into a capsule depending on its particle size. Also disclosed in the reference are suitable binders that may be used in the dosage forms such as pre-gelatinized starch, which makes up 50 to 99 percent of the dosage form, which encompasses the instant claims. It is calculated that the pre-gelatinized starch comprises 60 % of the instant formulation. Lubricants used include magnesium stearate and comprise typically an amount of less than about 1 weight percent of the pharmaceutical compositions or dosage forms into which they are incorporated. The information disclosed by Gennaro seems to be used when making capsules by ones of ordinary skill in the art, therefore making it obvious that whatever amount of material one has and the particle size of the material will determine the capsule size. Considering this, the formulations of the instant claims are not distinguishable from that of the prior art.

The combination of references supporting the 103 rejection provide a reasonable expectation of success via the bracketed capsule sizes, carrier amounts, etc. that all reasonably would be reasonably expected to be successful in capsule formulations within the range of these sizes and values as set forth in the references. Applicants argued this with allegations of difficulties regarding flowability of thalidomide in formulations but did not provide any factual basis for this. Allegations without factual basis are non-persuasive.

The Applicant is still advised to provide a showing comparing thalidomide formulations comprising 50 mg of thalidomide or the other amounts recited in the instant claims with formulations comprising the same amount of the thalidomide with different carriers in the same amounts as those in the instant claims. The Applicant argues there is a long felt need for capsules of this size. The Applicant is advised to provide supporting evidence for this argument.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lezah W. Roberts whose telephone number is 571-272-1071. The examiner can normally be reached on 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ardin H. Marschel can be reached on 571-272-0718. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Lezah Roberts
Patent Examiner
Art Unit 1614

Ardin Marschel
Supervisory Patent Examiner
Art Unit 1614

Ardin H. Marschel 6/26/06
ARDIN H. MARSCHEL
SUPERVISORY PATENT EXAMINER